



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : BRADLEY C. SAMMANN ET AL.  
Confirmation No.: 8547  
Serial No. : 10/608,238  
Filed : June 27, 2003  
TC/A.U. : 3746  
Examiner :

Docket No. : EH-10677 (02-639)  
Customer No. : 34704

MS Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313

PETITION UNDER 37 C.F.R. 5.25 AND 35 U.S.C. 184

Sir:

Applicant petitions that a foreign filing license for the patent application material disclosed in the above-identified '238 application be granted retroactive to June 27, 2003 to avoid abandonment of the above-identified application. A check for the required petition fee is enclosed.

As required in 37 C.F.R. 5.25(a)(1) and (2) the undersigned lists that unlicensed patent material was filed in the European Patent Office (EP) on December 24, 2003 as Ser. No. 03258149.8 under circumstances discussed in further detail below.

As required by 37 C.F.R. 5.25(a)(3) the undersigned hereby declares as follows:

The subject matter in question was not under a secrecy order at the time it was filed abroad and is not currently under a secrecy order.

The license has been diligently sought after discovery of the prescribed foreign filing in that the prescribed nature of the

foreign filing was realized in the afternoon of March 4, 2004. The undersigned had received and reviewed the filing receipt in application 10/722,158 (see below) earlier that morning. In the afternoon, in the course of reviewing unrelated material, the undersigned encountered a discussion of foreign filing licenses and had a lightning bolt-like realization that there may have been problems with the '158 application. The undersigned that day took prompt action to investigate the relevant statutory and regulatory provisions and begin to prepare a petition regarding the '158 application (that petition was filed March 17, 2004). The undersigned also investigated other cases noted below including the present case.

As is discussed below, either no additional foreign filing license was required under 37 C.F.R. 5.11 (e) (3) (iii) or the material was filed abroad through error and without deceptive intent without the required license under 37 C.F.R. 5.11 first having been obtained. The circumstances of such filing relate to the filing of the above-identified application and three other applications in related technology. The four applications are:

| Serial Number | Filing Date       |
|---------------|-------------------|
| 10/334,019    | December 30, 2002 |
| 10/608,238    | June 27, 2003     |
| 10/608,939    | June 26, 2003     |
| 10/722,158    | November 24, 2003 |

The first-filed '019 application has claims broadly directed to techniques for initiating deflagration-type combustion and specifically directed to use of those techniques in hybrid gas turbine engines with a particular embodiment of a gas turbine engine illustrated. The '019 case is not under secrecy order and

six months had past from the time of its filing well before the foreign filing process discussed below began.

The basic structure of the hybrid engine embodiment shown in the '019 application had previously been identified for use with detonation-type combustion in an invention disclosure (an internal corporate document). Earlier structures utilizing the basic principles had been yet previously identified in other invention disclosures. Greatest filing priority, however, had been given to the deflagration-related disclosure which gave rise to the '019 application thus causing that disclosure to be filed prior to filing on earlier-envisioned disclosure.

Accordingly, the '238 application was later filed with claims directed to the basic principles common to the previous invention disclosures and the illustrated embodiment of the '019 application. Thus the broad claims were not limited to detonation or deflagration. The principal illustrated embodiment was, thus, nearly identical to that of the '019 application except it featured a basic detonation-type ignition rather than the more complex deflagration-type ignition of the '019 application. An alternate embodiment from one of the yet-previous invention disclosures was also included as FIG. 10. The '238 application was appropriately made a Continuation-in-Part of the '019 application.

The '939 application was prepared roughly simultaneously with the '238 application. The '939 application is directed to a hybrid gas turbine engine having an alternate combustor structure to the exemplary embodiments of the '019 and '238 applications. A foreign filing license was granted in that case on September 12, 2003. Accordingly, no petition regarding foreign filing of that case is believed to be presently required.

The '158 application is directed to a sealing system for combustor carousels of hybrid engines such as those in the '019 and '238 applications. Certain features of the '158 application are clearly disclosed in the '019 and '238 applications. However, others, particularly discussions of dimensional ranges are not. As with the disclosures that gave rise to the '238 application, the '158 application is based on the disclosure submitted earlier than that of the '019 application but which was assigned a lower priority. It is for this reason that so much of the disclosure of the '158 application was included in the '019 application.

As a result of the earliest filing date of the '019 application, it was decided to simultaneously foreign file the '019, '238, and '158 applications to avoid prior art complications abroad. It was later realized that, in addition to the '019, '238, and the '158 applications, the '939 application need to be considered because certain prophetic (non-illustrated) alternate embodiments identified in the earlier applications might cause prior art problems if foreign filing of that case did not occur simultaneously. Convention foreign filing of the '019 patent application had to take place by December 30, 2003.

The assignee indicated a desire to file in the EPO. Advice from an EP attorney was required as to the exact priority implications and appropriate Paris Convention claims. This advice was sought in early December, 2003, by faxing the four applications to European patent attorney David Leckey on December 3, 2003. At that point, although the '019 application had a foreign filing license under 37 CFR 5.11 (e) (2), the undersigned failed to appreciate that express foreign filing licenses in the other applications had not been granted. As discussed above, it was only after review of the '158 application filing receipt on

March 4, 2004, that it became appreciated that a foreign filing license might have been needed in this application.

However, it is believed that relative to the '019 and '938 applications the present "modifications, amendments, and supplements do not, or did not, change the general nature of the invention in a manner which would require any corresponding United States application to be or have been available for inspection under 35 U.S.C. 181" and thus no additional foreign filing license was required under 37 C.F.R. 5.11 (e) (3) (iii). Nevertheless, this petition is submitted.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.



William B. Slate

Reg. No. 37,238

3/18/04

Date